UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

Taylor

Mailed: March 24, 2004

Opposition Nos. 91123141 and 91152132

Puma AG Rudolph Dassler Sport

v.

Samir Mourad DBA Don Regalon

(as consolidated)

Before Chapman, Bottorff and Drost, Administrative Trademark Judges.

By the Board:

CONSOLIDATION ORDERED

Preliminarily, the Board notes that the parties are involved in two proceedings which involve common questions of law and fact. Accordingly, the Board hereby orders the consolidation of Opposition Nos. 91123141 and 91152132.[1]

The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v.*

[1] When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *see also*, *Regatta Sport Ltd. v. Telux-Pioneer Inc.,* 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp*., 18 USPQ2d 1382 (TTAB 1991).

Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board file will be maintained in Opposition No. 91123141 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed herein; but that copy should bear both proceeding numbers in its caption.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

It is also noted that essentially identical cross motions for summary judgment have been filed and are pending in both of the now consolidated proceedings. These motions are decided below in a single opinion.

THE PARTIES' MOTIONS FOR SUMMARY JUDGMENT

Samir Mourad ("applicant") seeks to register the marks "V and leaping cat design" (the subject of Opposition No. 91123141) as shown below,

for "clothing, namely t-shirts, overalls, polo shirts, knit shirts, sweaters, belts, ties, pants, shirts, jackets, shorts, suits, socks, and underwear"[2]; and "VARESSI with a leaping cat design" (the subject of Opposition No. 91152132) as shown below,

VARESSI

for "clothing, namely, t-shirts, overalls, polo shirts, knit shirts, sweaters, belts, ties, pants, shirts, jackets, shorts, suits, socks, and underwear."[3]

Registration has been opposed by Puma AG Rudolph Dassler Sport ("opposer") in each proceeding on the grounds of priority of use and likelihood of confusion with its previously used "D and leaping cat design mark" as shown below,

and its numerous previously used and registered marks, e.g., Registration No. 1,354,044 for a leaping cat design, shown below,

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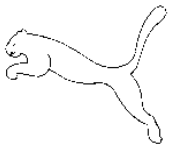
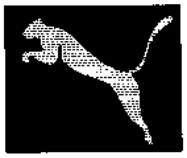
[2] Application Serial No. 75936519 filed March 4, 2004. The application is based on applicant's asserted bona fide intent to use the mark in commerce.

[3] Application Serial No. 75936520 filed on March 4, 2000. The application is based on applicant's asserted bona fide intent to use the mark in commerce.



for goods which include, *inter alia,* "clothing-namely, leisure shoes, boots, house slippers, sports shoes, sports and leisure clothing-namely, training suits, shorts, sweaters, pullovers, T-shirts, tennis wear, ski wear, leisure suits, all weather suits, wind resistant jackets, slickers, stockings, soccer socks, gloves, caps, headbands, bathing trunks and bathing suits"; and Registration No. 1,039,274 for a "leaping cat" mark, shown below,



for "football shoes; baseball shoes; training shoes; track shoes; boxing shoes; basketball shoes; soccer shoes; tennis shoes; bathing shoes; sneakers; golf shoes; ski boots; tennis garments for men - namely, tricot shirts, shorts; socks; overalls for men; sweatsuits for men; sweat shirts for men; sport shirts for men."[4]

Opposer also has alleged that registration and use by applicant of its involved marks will dilute the distinctive

[4] Opposer has also pleaded, among others, ownership of Registration No. 1,095,276. It is noted, however, that Registration No. 1,095,276 expired on April 12, 1999.

quality and public association of opposer's leaping cat marks, all to opposer's damage.

Applicant, in its answer, has denied the essential allegations of the notices of opposition. Applicant also has pleaded certain affirmative defenses and made amplifications of its denials.[5]

This case now comes up for consideration of (A) applicant's motions for summary judgment on the grounds that 1) opposer is estopped from arguing there is a likelihood of confusion between opposer's puma marks and applicant's tiger marks because opposer took a contrary position during the prosecution of the application which matured into one of its pleaded registrations, i.e., "file wrapper estoppel," and 2) there is no likelihood of confusion between the parties' asserted marks; and (B) opposer's cross-motions for summary judgment on the issues of priority of use and likelihood of confusion.[6]

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material

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[5] Applicant has asserted as an affirmative defense that it owns a "family" of marks. Without reaching the merits of whether applicant, in fact, has a family of marks, that claim is not a proper defense for a party in the position of defendant. See, e.g., *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 25 USPQ2d 1048 (TTAB 1992). Accordingly, the "family of marks" defense shall be given no further consideration in these cases.

[6] Applicant's motion (filed September 22, 2003) to extend its time to respond to opposer's cross-motion for summary judgment, with opposer's consent, is granted. See Fed. R. Civ. P. 6(b).

fact in dispute, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). That is, the moving party in each of the pending motions has the burden as to its motion. Additionally, the evidence must be viewed in a light favorable to the non-movant in each party's pending motion, and all justifiable inferences are to be drawn in the non-movant's favor. *See Opryland USA, Inc. v. Great American Music Show, Inc.,* 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993).

The mere fact that cross-motions for summary judgment on an issue have been filed does not necessarily mean that there are no genuine issues of material fact, and that trial is unnecessary. See Vol. 10A, Wright, Miller & Kane, *Federal Practice and Procedure*: Civil 3d § 2720.

After reviewing the arguments and supporting papers of the parties, we conclude that disposition of this matter by summary judgment is inappropriate. As to the issue of "file wrapper estoppel," contrary to applicant's position in this case, applicant, as a matter of law, is not entitled to judgment in these proceedings merely because of opposer's prior allegedly "inconsistent" statements. As stated by the

court in *Interstate Brands Corporation v. Celestial Seasoning, Inc*., 575 F.2d 926, 198 USPQ 151 (CCPA 1978), "[t]hat a party earlier indicated a contrary opinion respecting the conclusion in a similar proceeding involving similar marks and goods is a fact, and that fact may be received in evidence as merely illuminative of shade and tone in the total picture confronting the decision maker. To that limited extent, a party's earlier contrary opinion may be considered relevant and competent. Under no circumstances may a party's opinion, earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record." Thus, although opposer's prior statements have evidentiary value on the issue of likelihood of confusion in these opposition proceedings, they have no preclusive or estoppel effect. Applicant's motion for summary judgment on this issue accordingly is denied.

As to the issue of likelihood of confusion, or a lack thereof, at a minimum, there exist genuine issues of material fact as to the commercial impressions created by the parties' marks, and as to the extent of use by third parties of marks containing a "leaping cat" design with

other matter[7] and, thus, as to the scope of protection to be afforded opposer's pleaded marks.[8]

In view thereof, applicant's motions for summary judgment are denied and opposer's cross-motions for summary judgment are denied.[9]

All pending motions having been resolved, these consolidated proceedings are resumed. Discovery having already closed, trial dates are reset as indicated below.

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close:	May 20, 2004

[7] For purposes of summary judgment, applicant's search report showing third-party applications and registrations for marks including "leaping cat" designs in combination with other matter, for clothing and footwear, is sufficient to raise a genuine issue of material fact as to the extent of third-party use of such marks. *See Lloyd's Foods Products, Inc. v. Eli's Inc.,* 987 F.2d 766, 25 USPQ 2027 (Fed. Cir. 1993). However, such search reports have no evidentiary value at trial. See, e.g., *Weyerhaeuser Co. v. Katz*, 24 USPQ 2d 1230, 1231-32 (TTAB 1992); TBMP § 704.03(b)(1)(B)(2d ed. June 2003).

[8] The fact that we have identified and discussed only a few genuine issues of material fact as sufficient bases for denying the motions for summary judgment should not be construed as a finding that these are necessarily the only issues that remain for trial.

[9] We have not considered opposer's ownership of Registration No. 1,189,319 in this decision, as opposer did not plead ownership thereof in its notices of opposition. Likewise, this registration will not be considered at trial absent an amendment of the pleadings. See Trademark Rule 2.106(b)(1), 37 C.F.R. § 2.106(b)(1).
Additionally, evidence submitted in connection with the parties' motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial periods. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993).

30-day testimony period for party in position of defendant to close:	July 19, 2004
15-day rebuttal testimony period to close:	September 2, 2004

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rule 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.